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09/595,388	06/14/2000	Asil T. Gokcebay	537P	8754

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
2635	3

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/595,388	Applicant(s) GOKCEBAY ET AL.
	Examiner Edwin C. Holloway, III	Art Unit 2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 June 2000 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-26 is/are rejected.

7)  Claim(s) 1-26 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

***EXAMINER'S RESPONSE***

1. In response to the application filed 6-14-00, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: The status of all patent applications listed in

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the continuing data should be updated to reflect the current status of the applications including patent number 6552650 for serial number 08/705843.

Appropriate correction is required.

***Claim Objections***

5. Claims 1-26 are objected to because of the following informalities: Claims 1, 15 18 and 25 include "identification device or memory cell" and these claims and depend claims later refer to "the ID device" or "the memory cell" instead of using consistent terminology. It is suggested that one of the terms be eliminated from the claims or that the terms be combined, such as "ID memory cell," in order to be consistent. Appropriate correction is required.

***Claim Rejections - 35 USC § 102 & 103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of

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this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-2, 11, 15, 17, 18, 20 and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Stinar (US 5003801).

Stinar discloses a key device of independent claims 1, 15, 18 and 25 with metal (steel or brass) blade or shank 14 double cut with a pattern of bitting shown in fig. 1 and formed into a head or handle 12 at the upper end including a data contacts or terminals (16 and 18) isolated from the shaft. The key shaft for the ground terminal and the head includes an ID device or code element 111-118. See col. 2 lines 11-61. The ID device

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may be a programmable memory in col. 3 lines 48-52. Data is communicated via a single data terminal corresponding to a one wire bus. Regarding claim 2, the handle portion formed at the upper end of the shaft in col. 2 lines 14-15 represents an integral blade and head. Regarding claim 11, the data contact is in the front of the head adjacent to the key shoulder in fig. 1 and col. 2 lines 13-16. Regarding claim 17 and 20, the key shaft acts as a ground contact in col. 2 lines 37-42 and col. 3 line 1. Regarding claim 26, the key cuts 14 interacting with tumblers in col. 2 lines 24-27 acts as retention means.

10. Claims 1-21 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358) and Bolan (US 4945217).

Stinar is discussed above.

Bolan discloses an electronic key or token such as DS1207 including an integrated single chip with serial access memory communicating using a one wire bus protocol. The device includes a flexible circuit board, battery and two external contacts to form a sealed durable package that may be attached to an item to be tagged. See col. 1 line 57 - col. 2 line 62. This device includes a circular, coin or button shaped casing shown in fig. 1A and known as a touch memory or iButton. The

casing has external finished dimension of 16mm wide and 3.2 mm thick.

Seckinger discloses a programmable electronic key with a metal shaft or shank 1 having coding or bitting 3 and a grip or head 2 with recesses 6A-D for receiving circuits including contacts, connectors, processor, memory and battery. At least the battery recess is circular in shape has a metal housing of standard key dimensions for mechanical strength and stability that may include a non-detachable closure and may have plastic shell covers. See col. 2 lines 28-68 and col. 3 line 39 - col. 9 line 9. Memory is recited in claim 10.

Regarding claims 1-2, 11, 15, 17, 18, 20 and 25-26 if one wire bus is not clear in Stinar then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a one wire bus protocol in the key of Stinar in view of the one wire bus used in Bolan as a key or token because this is suggested by the communication over one data terminal in Stinar and because Bolan includes advantages such as a sealed durable package. This combination is further suggested by the key of Seckinger including flexible circuit board and circular recess to receive a button shaped device resembling the device or Bolan. If an integral key shaft and head is not clear in Stinar then such would have been obvious in

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view of integral metal key shank and grip of Seckinger for mechanical strength and stability. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a one wire bus protocol in the key of Seckinger in view of the one wire bus used in Bolan as a key or token because this is suggested by the communication over one data terminal in the key of Stinar and because Bolan includes advantages such as a sealed durable package. This combination is further suggested by the key of Seckinger including flexible circuit board and circular recess to receive a button shaped device resembling the device of Bolan.

Regarding claims 3-5, 7-8, 16 and 19 Seckinger includes a recess to receive the ID device and battery, the particular dimensions would have been obvious in view of the dimension of the button shaped device of Bolan and suggested by the circular recess for button shaped device of Seckinger. Regarding claim 6, the device of Bolan includes a battery for power. Regarding claims 9-10 Seckinger includes a plastic cover with two half shells in col. 7 lines 7-8 and conductors 8A suggested by the handing with molded insulating material in claim 8 of Stinar. Regarding claims 12-13, the Seckinger includes contacts 4 on both sides of the blade or shank for reversible operation similar to the two contacts of Stinar. Regarding claim 21, the device of Bolan is

a sealed can with battery and memory on a flexible circuit board. Regarding claim 14, the sealed can including a microcontroller would have been obvious in view of the processor on a flexible circuit board connected to battery in Seckinger. Regarding claim 26, the key blade mechanical coding of Stinar or Seckinger function as retention means.

11. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358) and Bolan (US 4945217) as applied above and further in view of Lemelson (US 4200227). Lemelson discloses a metal key 11 with teeth 14 on the blade and electronic code circuits or chips (36,38) disposed in recesses (34,35) of a two part plastic cover (21,30) forming housing 20 over the head 15. See col. 2 line 27 - col. 3 line 21. Alternatively, two button shaped circuits may be placed in a hole of the head and sealed to each other in col. 4 lines 19-39 to avoid an enlarged key head. This provides convenient circuit location that is simple and easy to assemble so that the circuits are sealed from corrosion in col. 1 line 5 - col. 2 line 10. Regarding claims 1-21 and 24-25 this structure of Lemelson including an integral solid metal key with circular recess receiving a circuit in a button shaped housing if further suggestion to deposit the button shaped circuit of

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Bolan in a recess in the head of and integral metal key. This provides the combination of a mechanical key coding and electronic coding with a sealed housing protecting the electronic circuits from corrosion. Regarding claims 22-24 two cells, or a cell and battery, would have further been obvious in view of the two button circuits sealed to each other in Lemelson as an alternative assembly to avoid the need of an enlarged key head. Two contacts are suggested by the symmetrical contacts of Stinar and Seckinger for reversible operation and separate circuit unit and batter are suggested by the circuit board 5 and separate battery 10 of Seckinger.

12. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Janssen (US 5836187), Sues (US 5229648), Suh (US 4697171) or Soong (UK 2291106). Janssen, Sues, Suh and Soong disclose electronic keys with contacts on the side of the blade. If contacts on the sides of the blades are not Seckinger then this would have been an obvious variation in location of parts in view of Janssen, Sues, Suh or Soong having contacts located on the blade. In particular, Sues includes

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contacts on the blade in fig. 2C as an alternative to contacts on the head near the shoulder of the blade in fig. 2A.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Gelhard (US 4663952). If microcomputer is not clear in the combination applied above then such would have been obvious in view of Gelhard so that both the key and the lock include intelligence for highly sophisticated dialogue assuring extremely high security against sabotage in col. 4 lines 1-13 of Gelhard and suggested by the processor in col. 6 of Seckinger.

14. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stinar (US 5003801), Seckinger (US 4686358), Bolan (US 4945217) and Lemelson (US 4200227) as applied above and further in view of Clarkson (US 4789859). If mechanical coding (bits, cuts or depressions) on the shaft is not clearly key blade retention means in the combination applied above then such would have been obvious in view of Clarkson disclosing in col. 4 lines 44-47 use of a bit or notch interacting with a

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centering and retention device in the cylinder to ensure proper location of the key in the keyway.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adkins (4438426), Rak (US 4642631), Vaughan (US 4871886), Imedio (US 4947662), Hyatt (US 5319362), Ozawa (US 5768925) and Layton (US 5775148) disclose electronic keys. Schafer (US 5212729), Ward (US 5259491) and Castleman (US 5461218) disclose touch memory devices.

***CONTACT INFORMATION***

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is **(703) 305-4700**.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH  
8/8/03

  
**EDWIN C. HOLLOWAY, III**  
**PRIMARY EXAMINER**  
**ART UNIT 2635**